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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/634,016

08/04/2003

Yoshinori Nishikitani

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03/02/2004

LAW OFFICE OF LAWRENCE E LAUBSCHER, JR  
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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/634,016

Applicant(s)

NISHIKITANI ET AL.

Examiner

Thong Q. Nguyen

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AW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/4/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The information disclosure statement filed on 8/4/2003 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

In particular, the foreign reference labeled as "JP 2858006" has been lined-through because applicant has failed to provide an explanation of the reference.

### ***Drawings***

3. The drawings contain eight sheets of figures 1(a) to 8 were received on 8/4/2003. These drawings are objected by the Examiner for the following reason(s).
4. The drawings are objected to because the figure 8 contains a character in the form of a foreign language. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
6. The disclosure is objected to because of the following informalities: a) Page 12: line 6, "x (1-h). Herein "h" indicates" should be changed to — x (1-h) wherein h indicates —; b) Page 13: line 20, "holder10" should be changed to – holder 10 --. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.
7. The attempt to incorporate subject matter into this application by reference to the reference 9-24768 is improper because it is a foreign reference.

### ***Claim Objections***

8. Claim 19 is objected to because of the following informalities. Appropriate correction is required.

Claim 19 is objected to because it contains more than one period in the claim.

Should "x (1-h). h: a ratio" (line 2) be changed to — x (1-h) wherein h indicates a ratio—to make clear the feature claimed?

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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10. Claims 13-16 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a) Claim 13 is rejected under 35 USC 112, first paragraph because the specification has not disclose any embodiment having a signal generator in the form of a specific light sensor and a control circuit for operating on the output of the specific light sensor as claimed. Applicant is respectfully invited to review the specification, in particular, in pages 10-13 and fig. 7 in which the specification discloses the use of a signal generator (means) for generating an electric signal to a control circuit wherein the signal generator comprises a manual switch (41) for control the color of the mirror by a manual manner and a set of two sensors, i.e., a specific light sensor (42) and a surrounding light sensor (43) for controlling the color of the mirror by an automatic manner. When the switch (41) is activated then a signal outputted from a manual information input unit is inputted to the drive-electric energy output unit of the control unit so that it can control the operation of the mirror. When an automatic control of the mirror is activated by the switch then the control circuit controls the operation of the mirror based on the signals provided by both the specific light sensor (42) and the surrounding light sensor (43) via a set of components of the control unit which components are not used when the manual operation is used.

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b) Claim 15 is rejected under 35 USC 112, first paragraph for the similar reason as set forth in element a) above

c) Claim 20 is rejected under 35 USC 112, first paragraph because the specification has not disclosed any embodiment wherein the mirror is operated by only the manual switch (41) and the specific light sensor (42) as claimed.

d) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiencies thereof.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-2, 5, 7, 10-13, 15, 17, 20 and 22, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Ledroit et al (U.S. Patent No. 5,691,849).

Ledroit et al disclose a rearview assembly for a vehicle and an adaptor for attaching an antiglare mirror assembly on a pre-mounted mirror. In the embodiment described in columns 2-6 and shown in figure 3, the rearview assembly (10) comprises a pre-mounted mirror assembly having a mirror (16) and an antiglare mirror assembly (320) having a housing (26) supporting a set of optical elements and a connecting mechanism (25, 28) for removably attaching the antiglare mirror assembly (320) onto the pre-mounted mirror. The antiglare

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mirror assembly comprises a transparent conductive electrode layer, a reflective electrode layer and an antiglare material in the form of a combination of electrochromic compound in an electrolyte transmissive fluid. A control system (318) disposed inside the housing supporting the antiglare mirror which system comprises two detectors and a circuit for controlling the color or non-color of the antiglare mirror based on the outputs from the detectors. The operation of the control system is made by power from the battery of the vehicle. It is also noted that the use of a manual system in the form of a slider or a knob for controlling the operation of the antiglare mirror with or without an automatic system is disclosed by Ledroit et al as can be seen in column 4. The detectors used in the system comprises a detector for detecting light from a rear of the vehicle and the other detector is for detecting the brightness surrounding the vehicle.

13. Claims 1-2, 6-7, 10-13, 15, 17, 20 and 22, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Ledroit et al (U.S. Patent No. 5,691,849).

Ledroit et al disclose a rearview assembly for a vehicle and an adaptor for attaching an antiglare mirror assembly on a pre-mounted mirror. In the embodiment described in columns 2-6 and shown in figure 1, the rearview assembly (10) comprises a pre-mounted mirror assembly having a mirror (16) and an antiglare mirror assembly (20) having a housing (26) supporting a set of optical elements and a connecting mechanism (25, 28) for removably attaching the antiglare mirror assembly (20) onto the pre-mounted mirror. The antiglare

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mirror assembly comprises a transparent conductive electrode layer, a reflective electrode layer and an antiglare material in the form of a combination of electrochromic compound in an electrolyte transmissive fluid. A control system (18) disposed inside the pre-mounted mirror assembly supporting the mirror (16) which system comprises two detectors and a circuit for controlling the color or non-color of the antiglare mirror based on the outputs from the detectors. The operation of the control system is made by power from the battery of the vehicle. It is also noted that the use of a manual system in the form of a slider or a knob for controlling the operation of the antiglare mirror with or without an automatic system is disclosed by Ledroit et al as can be seen in column 4. The detectors used in the system comprise a detector for detecting light from a rear of the vehicle and the other detector is for detecting the brightness surrounding the vehicle.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ledroit et al in view of the Japanese reference No. 58-184352 (submitted by applicant).

The antiglare mirror assembly having an antiglare mirror system which is removably attached to a pre-mounted mirror assembly as provided by Ledroit et



al meets all of the limitations recited in the present claim 3 except the arrangement of the clip member for removably connecting the housing of the pre-mounted mirror assembly and the housing of the antiglare mirror assembly. In particular, the system provided by Ledroit et al does not disclose that the clip member for attaching the two housings is made in a manner that the housing of the pre-mounted mirror assembly is disposed inside the housing of the antiglare mirror assembly when the two housings are connected together. However, a rearrangement of components is an obvious matter to one skilled in the art as clearly determined by the Courts. Further, the use of a clip member for removably connecting two housings each supporting a mirror element is known to one skilled in the art as can be seen in the mirror system provided in the Japanese reference No. '352. See English abstract, pages 519-523 and figs. 1-3. Thus, it would have been obvious to one skilled in the art at the time the invention was made to rearrange the positions of the connecting system as suggested by the Japanese reference No. '352 for the purpose of providing a means for easier removing the two housings.

16. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ledroit et al in view of the Japanese reference No. 5-286393 (submitted by applicant).

The antiglare mirror assembly having an antiglare mirror system which is removably attached to a pre-mounted mirror assembly as provided by Ledroit et al meets all of the limitations recited in the present claim 4 except the use of a rubber band for removably connecting the housing of the pre-mounted mirror

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assembly and the housing of the antiglare mirror assembly. However, the use of a rubber band for removably connecting the two housings as claimed is merely that of a preferred embodiment and no criticality has been disclosed. The support for that conclusion is found in the present specification in which applicant has disclosed another embodiment in which the two housings are removably connected to each other via a mechanism having mechanical clip member. It is also noted that such use of a clip member is indeed claimed as can be seen in present claim 3. Further, the use of a rubber band for removably connecting the two housings supporting mirrors is disclosed in the art as can be seen in the mirror system described in the Japanese reference No. '393. See the English abstract, columns 1-2 and fig. 2. Thus, absent any showing of criticality, it would have been obvious to one skilled in the art at the time the invention was made to utilize any suitable mechanism including a rubber band as suggested by the Japanese reference No. '393 for the purpose of providing a means for easier removing the two housings.

17. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ledroit et al in view of Varaprasad et al (U.S. Patent No. 5,724,187).

The antiglare mirror assembly provided by Ledroit et al does not explicitly disclose that the antiglare material comprises a light transmissive electrolyte layer and an electrochromic compound layer as claimed. However, the use of an antiglare material having transmissive electrolyte layer and an electrochromic compound layer as claimed is merely that of a preferred embodiment and no

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criticality has been disclosed. The support for that conclusion is found in the present specification in which applicant has disclosed another embodiment in which the antiglare material is made by a combination of electrochromic compound in a transmissive electrolyte. It is also noted that such a different structure of the antiglare material is indeed claimed as can be seen in the present claim 7. Further, the use of a combination of electrochromic compound in a transmissive electrolyte in an antiglare mirror system is disclosed in the art as can be seen in the mirror system described in the U.S. Patent No. '187. See columns 36+. Thus, absent any showing of criticality, it would have been obvious to one skilled in the art at the time the invention was made to utilize any suitable combination of electrolyte material in combination with a reflective conduct electrode layer including the ones provided in the Patent '187 for the purpose of producing an antiglare mirror system having function to reduce the glare to a vehicle driver.

17. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ledroit et al in view of Law (U.S. Patent No. 5,204,991).

The antiglare mirror assembly provided by Ledroit et al comprises an electronic circuit which is fed with electric power from the electric system of the vehicle via a terminal. See column 4, lines 58+. However, Ledroit et al do not explicitly state that the circuit is connected to a socket of a cigarette lighter of the vehicle. However, the use of a cigarette light of a vehicle as a connection for transmitting power from the battery of the vehicle to the electric automotive accessories is

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clearly known to one skilled in the art as can be seen in the system provided by Law. See columns 1 and 3-4 and fig. 1, for example. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the antiglare mirror assembly provided by Ledroit et al by connecting the control circuit controlling the operation of the antiglare mirror to the battery of the vehicle via the cigarette lighter as suggested by Law for the purpose of easier to connect/disconnect the control circuit from the battery of the vehicle.

18. Claims 14, 16 and 18-19, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ledroit et al in view of Nagao (U.S. Patent No. 5,768,020).

Ledroit et al disclose an antiglare mirror assembly having a set of detectors and a control circuit for controlling the operation of an antiglare mirror element based on the outputs provided by the detectors. However, Ledroit et al do not clearly disclose the connection between each of the detector and the control circuit comprises a judgment unit that judges the color of the signal with respect to a threshold value and then outputs a signal to the control circuit. However, the use of a control circuit having detectors and a circuit wherein a judgment circuit is used between the detectors and the control circuit for the purpose of determining whether a color of an antiglare mirror element needs to be varied based on the detecting signals of the detectors is suggested to one skilled in the art as can be seen in the system provided by Nagao. See columns 6-11. It is also noted that the selection of the color for an antiglare mirror from the outputs of the detectors

and the threshold values stored in the memory of a control circuit is considered as an obvious matter to one skilled in the art. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the antiglare mirror assembly provided by Ledroit et al by utilizing a control circuit having judgment units connected to the detectors and a control circuit as suggested by Nagao for the purpose of selectively adjusting the color of the antiglare mirror element based on the outputs of the detectors in comparison with predetermined/threshold values used in the system.

19. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ledroit et al in view of Carter (U.S. Patent No. 6,102,546).

The antiglare mirror assembly provided by Ledroit et al does not explicitly disclose the use of an indicator for the purpose of showing a driving state of the electrochromic mirror. However, the use of an indicator with an antiglare mirror system for the purpose of showing the driving state of the electrochromic mirror is clearly known to one skilled in the art as can be seen in the system provided by Carter. See column 3 and fig. 1, for example. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the antiglare mirror assembly provided by Ledroit et al by utilizing an indicator as suggested by Carter with the antiglare mirror assembly for the purpose of showing the driving state of the electrochromic mirror.

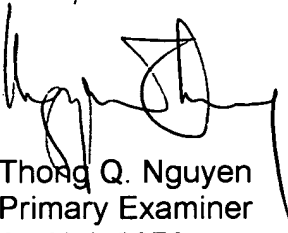
**Conclusion**

20. The prior art except the reference labeled as "JP 2858006" made of record and not relied upon is considered pertinent to applicant's disclosure.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

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